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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR    | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09 980,716      | 12 05 2001  | John Christopher Padget | P 0284098           | 7144             |

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EXAMINER

RIBAR, TRAVIS B

| ART UNIT | PAPER NUMBER |
|----------|--------------|
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1711

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DATE MAILED: 03 25 2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/980,716

Applicant(s)

PADGET ET AL.

Examiner

Travis B Ribar

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on 05 December 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☐ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 14-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 1-3 is/are rejected.
- 7) ☐ Claim(s) 4-13 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Election/Restrictions*

1. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group 1, claim(s) 1-13, drawn to an ink receptive substrate.

Group 2, claim(s) 14-18, drawn to a process for preparing an ink receptive substrate.

Group 3, claim(s) 19-20, drawn to a kit.

2. The inventions listed as Groups 1-3 do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: The special technical feature of groups 1 and 2 is the inclusion of a co-polymerizable surfactant in the composition. The special technical feature of group 3 is the combination of the ink receptive substrate and written instructions. Restriction between groups 1 and 2 is proper because the special technical feature is anticipated by the prior art (see the following office action) and therefore does not make a contribution over the prior art. The restriction regarding group 3 is proper because it does not contain the same special technical feature as the other groups.

3. During a telephone conversation with Mr. Steinberg on March 19, 2003 a provisional election was made with traverse to prosecute the invention of an ink receptive substrate, claims 1-13. Affirmation of this election must be made by applicant in replying to this Office action. Claims 14-20 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

4. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

#### ***Claim Objections***

5. Claims 4-13 are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim cannot depend from another multiple dependent claim. See MPEP § 608.01(n). Accordingly, the claims 4-13 have not been further treated on the merits.

#### ***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1-3 are rejected under 35 U.S.C. 102(b) as being anticipated by Dietz et al. ('561).

Dietz et al. ('561) discloses a pressure sensitive adhesive (PSA) coated on a substrate, meeting the support material requirement of claim 1. The PSA is formed by polymerizing a microemulsion that contains a co-polymerizable surfactant (column 17, line 59), which fulfills the remainder of the material limitations of claims 1 and 2. The microemulsion in Dietz et al. ('561) is made from water, a polymerizable oil, and the co-polymerizable surfactant (column 9, line 26; column 12, line 63; column 17, line 59), which meets the requirements of claim 3.

The PSA-coated substrate in the reference can be in the form of tapes (column 30, line 57) or bandages (column 29, line 1). Though the reference does not explicitly point out that the tapes or bandages may be ink receptive, the backing materials for the tapes and bandages include fibrous backings that are inherently ink receptive, allowing one to make identifying marks on a tape or bandage after it has been applied. This reference is therefore also deemed to meet the ink receptive requirement of the current claims.

Regarding the porous nature of the applicant's claimed invention, Dietz et al. ('561) discloses that the preferred embodiment of the invention is a nonporous solid (column 5, line 13). The disclosure that the preferred embodiment of the invention is nonporous, however, does not constitute the reference teaching away from using a

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porous material. In fact, it indicates that there are embodiments of the invention that, though not preferred, are in fact porous. Dietz et al. ('561) therefore meets the limitation of the current application that calls for the polymer layer on the support layer to be porous.

8. Claims 1-3 are rejected under 35 U.S.C. 102(b) as being anticipated by Dietz et al. ('557).

Dietz et al. ('557) discloses a pressure sensitive adhesive (PSA) coated on a substrate, meeting the support material requirement of claim 1. The PSA is formed by polymerizing a microemulsion that contains a co-polymerizable surfactant (column 17, lines 29-59 and column 18, lines 29-57), which fulfills the remainder of the material limitations of claims 1 and 2. The microemulsion in Dietz et al. ('557) is made from water, a polymerizable oil, and the co-polymerizable surfactant (column 9, line 56; column 13, line 29; column 17, lines 29-59; column 18, lines 29-57), which meets the requirements of claim 3.

The PSA-coated substrate in the reference can be in the form of tapes (column 32, line 12) or bandages (column 30, line 31). Though the reference does not explicitly point out that the tapes or bandages may be ink receptive, the backing materials for the tapes and bandages include fibrous backings that are inherently ink receptive, allowing one to make identifying marks on a tape or bandage after it has been applied. This reference is therefore also deemed to meet the ink receptive requirement of the current claims.

Regarding the porous nature of the applicant's claimed invention, Dietz et al. ('557) discloses that the preferred embodiment of the invention is a nonporous solid (column 33, line 64). The disclosure that the preferred embodiment of the invention is nonporous, however, does not constitute the reference teaching away from using a porous material. In fact, it indicates that there are embodiments of the invention that, though not preferred, are in fact porous. Dietz et al. ('557) therefore meets the limitation of the current application that calls for the polymer layer on the support layer to be porous.

### ***Conclusion***

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Schultz et al. discloses coatings utilizing surfactants.

Pekala discloses inkjet printable coatings.

10. The examiner notes the enclosed International search report and notes that the art applied in this office action is considered more relevant than that found within the search report.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Travis B Ribar whose telephone number is (703) 305-3140. The examiner can normally be reached on 8:30-5:00 Monday through Friday.


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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on (703) 308-2462. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

Travis B Ribar  
Examiner  
Art Unit 1711

TBR  
March 19, 2003



James Seidleck  
Supervisory Patent Examiner  
Technology Center